

Amendments to the Drawings

The attached drawing sheet includes changes to Fig. 32. This sheet replaces the original sheet. In the replacement sheet, element “98” has been removed from Figure 32.

Attachment: Replacement Sheet

Remarks/Arguments

Objections to the Drawings Under 37 CFR 1.84(p)(5)

The Examiner objected to the drawings under 37 CFR 1.84(p)(5) for showing reference character(s) not mentioned in the description. Applicants have attached a replacement drawing sheet in which the reference character “98” has been removed. Applicants courteously request that the objection be removed.

The Rejection of Claims 14 and 52-60 Under 35 U.S.C. §101

The Examiner rejected Claims 14 and 52-60 under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. As suggested by the Examiner, Applicants have amended Claim 14 to add a limitation reciting the storage of the strength ranking in a database. Applicants submit that the amendment overcomes the rejection under 35 U.S.C. §101. Claims 52-60, dependent from Claim 14, enjoy the same distinction with respect to 35 U.S.C. §101. Applicants courteously request that the rejection be removed.

The Rejection of Claims 14, 22 and 52-69 Under 35 U.S.C. §112

The Examiner rejected Claims 14, 22 and 52-69, under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicants have amended Claims 14 and 22 to address the antecedent basis problem cited by the Examiner. Specifically, Applicants have replaced “said group” with “said set” in the “analyzing” limitation for each claim.

Applicants respectfully submit that these amendments overcome the rejection of Claims 14 and 22 under 35 U.S.C. §112. Claims 52-60 and 61-69, dependent from Claims 14 and 22, respectively, enjoy the same distinction with respect to 35 U.S.C. §112.

Applicants courteously request that the rejection be removed.

The Rejection of Claims 14, 22, 52, 57, 60, 61, 66 and 69 Under 35 U.S.C. §102(a)

The Examiner rejected Claims 14, 22, 52, 57, 60, 61, 66 and 69 under 35 U.S.C. §102(a) as being anticipated by PCT Publication WO 00/75851 (Goffman et al).

Anticipation requires that all of the elements of the claim be taught within the four corners of a single reference.

Claim 14

Claim 14 recites: “analyzing said set of patents by consideration of at least one objective parameter of each patent in said set, said at least one objective parameter selected from the group consisting of: number of elements in an independent claim of said each patent, and number of *linguistic or textual components* in at least one independent claim in said each patent;” (emphasis added).

Paragraph [0059] of the subject application states: “Another metric relates to a weighted count of *linguistic or textual components* found in the claim(s) under study or of correlations among such components. *These components may be determined via analysis at various linguistic levels, including phonological, morphological, lexical, syntactic, semantic, discourse structure, or pragmatic levels.*” (emphasis added).

The website www.asis.org/Bulletin/Apr-98/liddy.html provides the following information and definitions:

“The levels of linguistic analysis are:

- **Phonological:** interpretation of speech sounds within and across words
- **Morphological:** componential analysis of words, including prefixes, suffixes and roots
- **Lexical:** word level analysis including lexical meaning and part of speech analysis
- **Syntactic:** analysis of words in a sentence in order to uncover the grammatical structure of the sentence
- **Semantic:** determining the possible meanings of a sentence, including disambiguation of words in context
- **Discourse:** interpreting structure and meaning conveyed by texts larger than a sentence
- **Pragmatic:** understanding the purposeful use of language in situations, particularly those aspects of language which require world knowledge”

The Examiner has cited page 19, lines 1-18 and page 20, lines 20-24 of Goffman as teaching the

above claim limitation. However, Goffman has no teaching regarding linguistic or textual components. Instead, on page 19, Goffman teaches mechanical processes such as measuring the lengths of data fields, counting entries in data fields, counting claims, claim clauses, citations, examples, numbers of figures, and priority claims. Regarding claim length, Goffman teaches counting the number of characters, words, paragraphs, columns of text, pages of text, number of graphics, or area of text or graphics. On page 20, Goffman teaches apprising claim length (number of words) and the number of number of independent claims. None of these processes or methods are related to linguistic or textual analysis. Therefore, Goffman does not anticipate the above limitation of Claim 14.

Claim 14 also recites: “assigning a strength ranking to said each patent responsive to said analysis” The Examiner has cited page 19, lines 1-18 and page 20, lines 20-24 of Goffman as teaching the above claim limitation. Applicants have shown that Goffman does not teach the analysis recited in Claim 14. Therefore, Goffman does not teach assigning a strength ranking based on the analysis and does not anticipate the above limitation of Claim 14.

For all the reasons noted above, Goffman does not teach all the elements of Claim 14 and Claim 14 is novel with respect to Goffman. Claims 52, 57 and 60, dependent from Claim 14, enjoy the same distinction with respect to Goffman.

Claim 22

Claim 22 is an apparatus claim paralleling method Claim 14. Therefore, the arguments regarding Claim 14 are applicable to Claim 22 and Claim 22 is novel with respect to Goffman. Claims 61, 66, and 69, dependent from Claim 22, enjoy the same distinction with respect to Goffman.

Applicants courteously request that the rejection be removed.

The Rejection of Claims 14 and 22 Under 35 U.S.C. §102(a)

The Examiner rejected Claims 14 and 22 under 35 USC 102(a) as being anticipated by Applicants’ admitted prior art.

Anticipation requires that all of the elements of the claim be taught within the four corners of a single reference.

Claim 14

Claim 14 recites: “analyzing said set of patents by consideration of at least one objective parameter of each patent in said set, said at least one objective parameter selected from the group consisting of: number of elements in an independent claim of said each patent, and number of *linguistic or textual components* in at least one independent claim in said each patent;” (emphasis added). The Examiner has cited paragraph [0012] of the instant application as teaching this claim limitation. Paragraph [0012] states:

“One such criterion relates to the claims of the patent. It is well known that the claims define the metes and bounds of an invention. Claims vary in scope, and experienced patent attorneys are routinely asked to read and evaluate the scope of patent claims. Claim scope is a quasi-subjective interpretation, but there are objective measurement criteria as well. For example, in general, the fewer elements in a claim - the broader its scope. The number of words in a claim can also be an indication of scope.”

The discussion, in the arguments regarding the anticipation rejection with respect to Goffman, of the terms recited in Claim 14 is applicable to the present rejection and in the interest of brevity is referenced, but not repeated. In light of the preceding referenced information, it is clear that paragraph [0012] does not teach, suggest, or motivate counting linguistic or textual components, as is recited in Claim 14. The paragraph merely teaches counting the number of elements or words in a claim. Linguistic or textual analysis of a claim is not the same as counting the number of elements or words in the claim. Therefore, the admitted prior art does not teach the above limitation of Claim 14.

Claim 14 also recites: “assigning a strength ranking to said each patent responsive to said analysis” The Examiner has cited paragraph [0014] of the instant application as teaching the preceding limitation. Applicants have shown that the admitted prior art does not teach the analysis recited in Claim 14. Therefore, the admitted prior art cannot teach assigning a strength ranking based on the analysis and does not teach the above limitation of Claim 14.

For all the reasons noted above, Applicants' admitted prior art does not teach all the elements of Claim 14 and therefore, Claim 14 is novel with respect to the prior art.

Claim 22

Claim 22 is an apparatus claim paralleling method Claim 14. Therefore, the arguments regarding Claim 14 are applicable to Claim 22 and Claim 22 is novel with respect to Applicants' admitted prior art.

Applicants courteously request that the rejection be removed.

Rejection of Claims 14 and 22 under 35 U.S.C. §103(a)

The Examiner rejected Claims 14 and 22 under 35 USC 103(a) as being unpatentable over Applicants' admitted prior art.

Applicants have shown that Applicants' admitted prior art does not teach all the elements of Claims 14 or 22. Counting the number of elements or words in a claim is utterly different than performing a linguistic analysis and the Examiner has provided no motivation or suggestion for modifying Applicants' admitted prior art to form the claimed invention. Nor does the admitted prior art contain any such motivation or suggestion, since linguistic analysis is so different than word counting. For all the reasons noted above, Claims 14 and 22 are patentable over Applicants' admitted prior art. Applicants courteously request that the rejection be removed.

Rejection of Claims 53, 54, 58, 59, 62, 63, 67 and 68 under 35 U.S.C. §103(a)

The Examiner rejected Claims 53, 54, 58, 59, 62, 63, 67 and 68 under 35 USC 103(a) as being unpatentable over PCT Publication WO 00/75851 (Goffman et al) as applied to Claims 14, 22, 52, 57, 60, 61, 66, and 69.

Claim 14

Applicants have shown that Goffman does not teach all the elements of Claim 14, nor does Goffman suggest or motivate the elements of Claim 14. Therefore, Claim 14 is patentable over Goffman. Claims 53, 54, 58 and 59, dependent from Claim 14, enjoy the same distinction with respect to Goffman.

Claim 22

Applicants have shown that Goffman does not teach all the elements of Claim 22, nor does Goffman suggest or motivate the elements of Claim 22. Therefore, Claim 22 is patentable over Goffman. Claims 62, 63, 67 and 68, dependent from Claim 22, enjoy the same distinction with respect to Goffman.

Applicants courteously request that the rejection be removed.

Rejection of Claims 55, 56, 64 and 65 under 35 U.S.C. §103(a)

The Examiner rejected Claims 55, 56, 64 and 65 under 35 USC 103(a) as being unpatentable over PCT Publication WO 00/75851 (Goffman et al) as applied to Claims 14, 22, 52, 57, 60, 61, 66, and 69 and further in view of U.S. Patent No. 5,774,833 (Newman).

Claim 14

Applicants have shown that Goffman does not teach, suggest, or motivate the elements of Claim 14. Newman teaches identifying semicolons in an independent claim and using the semicolons to count the number of claim elements. Newman does not teach, suggest, or motivate the linguistic analysis recited in Claim 14. Therefore, Newman does not cure the defects of Goffman with respect to Claim 14 and Claim 14 is patentable over Goffman and Newman. Claims 55 and 56, dependent from Claim 14, enjoy the same distinction with respect to Goffman and Newman.

Claim 22

Claim 22 is an apparatus claim paralleling method Claim 14. Therefore, the arguments regarding Claim 14 are applicable to Claim 22 and Claim 22 is patentable over Goffman and Newman. Claims 64 and 65, dependent from Claim 22, enjoy the same distinction with respect to Goffman and Newman.

Applicants courteously request that the rejection be removed.

Rejection of Claims 52-54, 57-63 and 66-69 under 35 U.S.C. §103(a)

The Examiner rejected Claims 52-54, 57-63 and 66-69 under 35 USC 103(a) as being unpatentable over Applicants' admitted prior art.

Claim 14

Applicants have shown that Applicants' admitted prior art does not teach, suggest, or motivate the elements of Claim 14. Therefore, Claim 14 is both novel with respect to and patentable over the admitted prior art. Claims 52-54 and 57-60, dependent from Claim 14, enjoy the same distinction with respect to the admitted prior art.

Claim 22

Applicants have shown that Applicants' admitted prior art does not teach, suggest, or motivate all the elements of Claim 22. Therefore, Claim 22 is both novel with respect to and patentable over the admitted prior art. Claims 61-63 and 66-69, dependent from Claim 22, enjoy the same distinction with respect to the admitted prior art.

Applicants courteously request that the rejection be removed.

Rejection of Claims 55, 56, 64 and 65 under 35 U.S.C. §103(a)

The Examiner rejected Claims 55, 56, 64 and 65 under 35 USC 103(a) as being unpatentable over Applicants' admitted prior art as applied to Claims 52-54, 57-63 and 66-69 and further in view of U.S. Patent No. 5,774,833 (Newman).

Claim 14

Applicants have shown that Claim 14 is both novel with respect to and patentable over Applicants' admitted prior art. Newman teaches identifying semicolons in an independent claim and using the semicolons to count the number of claim elements. Newman does not teach, suggest, or motivate the linguistic analysis recited in Claim 14. Therefore, Newman does not cure the defects of Applicants' admitted prior art with respect to Claim 14 and Claim 14 is patentable over the admitted prior art and Newman. Claims 55 and 56, dependent from Claim 14, enjoy the same distinction with respect to the admitted prior art and Newman.

Claim 22

Claim 22 is a system claim paralleling method Claim 14. Therefore, the arguments regarding Claim 14 are applicable to Claim 22 and Claim 22 is patentable over the admitted prior art and Newman. Claims 64 and 65, dependent from Claim 22, enjoy the same distinction with respect to the admitted prior art and Newman.

Applicants courteously request that the rejection be removed.

Conclusion

Applicant respectfully submits that all pending claims are now in condition for allowance, which action is courteously requested.

Respectfully submitted,

/C. Paul Maliszewski/

C. Paul Maliszewski
Registration No. 51,990
CUSTOMER NO. 24041
Simpson & Simpson, PLLC
5555 Main Street
Williamsville, NY 14221-5406
Telephone No. 716-626-1564

CPM/

Dated: October 31, 2006

Attorney Docket No. IPCP:109aUS
U.S. Patent Application No. 10/713,315
Response to Office Action Dated: August 15, 2006
Date: October 31, 2006

Appendix